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10/041,111	01/08/2002	Roger Javier Justo	TUC920000094US1	4477

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 6/30/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-49 is/are pending in the application.
- Of the above claim(s) 1-21, 36-49 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-35 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 0108
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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1. Applicant's election without traverse of claims 22-35 in Paper No. 0630 is acknowledged.

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23, 25 and 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, in claim²3, line 2 the phrase "differing dimensions" is unduly vague and indefinite since it is unclear as to what dimensions are being referred to. In claims 25 and 26, line 3 of each, the species "perfluoroalkoxy Teflon™" is improper due to the use of trademark in each of the claims.

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 22-35 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More

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particularly, the phrase "disposed on" which describes the relationship between the first electrically insulating coating on the elastomeric member appears much broader than the corresponding disclosure at page 2, the Summary of the Invention where it is apparently indicated that the aforementioned elastomer should "encapsulate" the thermally conductive elastomer and as such would appear to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Yamaguchi or the Chomerics product literature at page 43, each taken individually, or in view of Peterson. The primary references each appear to disclose (note particularly Yamaguchi, the Abstract and Figures, column 1 line 62 - column 2 line 9, column 2 lines 42-64, column 3 lines

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52-60, column 4 lines 16-23, lines 64-65, column 5 lines 26-36, claim 1; Chomerics literature regarding Therm-A-Gap A574 and F575 materials) or render obvious applicant's claimed structure in its intended environment, i.e. adjacent a plurality of heat dissipating components in an enclosure wherein a flexible thermally conductive assembly formed from a suitable conductive elastomeric member (Yamaguchi, column 4 lines 16-24) having an electrically insulating "first coating" such as a polyimide film (column 4, lines 64-65; applicant's claim 25) is present. A similar structure is shown in the Chomerics product literature wherein a silicone elastomer loaded with ceramic particles is coated onto a thin aluminum carrier. Note that applicant's claims require only the presence of a layer that is "disposed on" the elastomeric member, not a layer or suitable liquid which forms a coating and that encapsulates the elastomeric member. Alternatively, the secondary reference Peterson discloses (note particularly the Abstract, column 1 lines 38-43, column 2 lines 43-54) ~~teaches~~ utilizing a thermally conductive organosiloxane composition to form useful coatings and encapsulations of electronic solid state devices and other substrates as a method for increasing heat dissipation (column 1, lines 38-40). Accordingly, one of ordinary skill, motivated by an expectation of improved thermal dissipation properties would incorporate the aforementioned conductive compositions of Peterson into the heat

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conductor articles of the primary reference^s and thereby either form, or clearly render obvious, the claimed genus of articles. With respect to the dependent claims, such parameters as the presence of a metal layer such as aluminum (claims 27, 28) and a pressure sensitive adhesive disposed upon one of the surfaces of the thermally conductive assembly are each believed to be, if not expressly or inherently disclosed, obvious modifications to one of ordinary skill, in the absence of unexpected results.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

September 11, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300

1700

Daniel Zirker